

Applicants : Eric David Harper, *et al.*
Appl. No. : 10/736,038
Examiner : Murali K. Dega.
Docket No. : 20503-4023

REMARKS

Claims 1-25 are pending in the present application.

The specification is objected to.

Claims 1, 11, 21 and 23 are rejected under 35 U.S.C. §112, ¶1 as failing to comply with the written description requirement.

Claim 24 is rejected under 35 U.S.C. §112, ¶2 as being indefinite.

Claims 1-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,189,146 to Misra, *et al.* ("Misra") in view of U.S. Pub. No. 2005/0071280 to Irwin *et al.* ("Irwin"), and further in view of U.S. Patent No. 7,343,297 to Bergler, *et al.* ("Bergler").

Claims 1, 9, 11, 14, 21, and 23-24 are amended within the subject matter of the application as filed. It is respectfully submitted that no new matter has been added.

Reconsideration of the application as amended herein is respectfully requested.

OBJECTIONS

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter found in Claims 1, 11, 21, and 23. 12/07/2010 Office Action, pp. 2-3. Claims 1, 11, 21, and 23 are amended herein and Applicants respectfully submit that the Examiner's objection to the specification has been overcome.

CLAIM REJECTIONS

Rejections under 35 U.S.C. §112

Claims 1, 11, 21 and 23 are rejected under 35 U.S.C. §112, ¶1 as failing to comply with the written description requirement. 12/07/2010 Office Action, pp. 3-4. Claims 1, 11, 21, and

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23 are amended herein and Applicants respectfully submit the Examiner's rejections under 35 U.S.C. §112¶1 are overcome.

Claim 24 is rejected under 35 U.S.C. §112, ¶2 as being indefinite for failing to particularly point out and distinctly claim the invention. 12/07/2010 Office Action, p. 4. Claim 24 is amended herein and Applicants respectfully submit that the Examiner's rejection of Claim 24 under 35 U.S.C. §112¶2 has been overcome.

Rejections under 35 U.S.C. §103(a)

Claims 1-25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Misra in view of Irwin and further in view of Bergler. Applicants respectfully disagree and submit that Claims 1-25 are patentable under 35 U.S.C. §103(a) over Misra in view of Irwin and further in view of Bergler for at least the following reasons.

Claim 1 is amended to recite:

voluntary returning of the license and the plurality of license rights to the server comprises the first computer initiating return of the license and the plurality of license rights before an expiration of the license and the plurality of license rights.

Claim 1, emphasis added. Misra does not provide such a teaching. Misra describes a license generator at a license clearinghouse that creates a license pack containing a set of one or more individual software licenses. Misra, col. 4, ll. 1-9. A license server distributes the software licenses contained within the license pack to individual clients. Misra, col. 4, ll. 9-20. A license pack data structure includes an expiration date, and the expiration date is the date on which the licenses within the license pack will expire. Misra, Table 1, col. 7, lines 21-65. In other words, a license is freed up upon expiration, and the expiration date is determined by the entity generating the license pack, not the client. Misra does not teach:

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voluntary returning of the license and the plurality of license rights to the server comprises the first computer initiating return of the license and the plurality of license rights before an expiration of the license and the plurality of license rights.

Claim 1, emphasis added.

Irwin does not provide such a teaching either. Irwin describes protecting the distribution of digital information while allowing a user to authorize the user of digital information on a variety of devices. Irwin, ¶[0003]. An intermediate rights provider receives a master license, and a child license can be created from the master license. Irwin, ¶[0054]. A child license is a license whose rights depend from the master license. *Id.* Multiple devices registered within a local rights provider can access a key to all licensed digital content. Irwin, ¶[0159].

Transferring of digital rights directly from one registered device to another is possible, in the event one device is lost or broken. Irwin, ¶¶[0165-0169]. Irwin does not disclose:

voluntary returning of the license and the plurality of license rights to the server comprises the first computer initiating return of the license and the plurality of license rights before an expiration of the license and the plurality of license rights.

Claim 1, emphasis added.

Bergler does not provide such a teaching either. Bergler describes that any license previously issued to a client that has been returned by the license clean-up module is subject to being given to a different client. Bergler, col. 12, lines 14-17. Licenses are returned to the available license pool based on expiration date. Bergler, col. 11, ll. 55-65. Bergler does not disclose:

voluntary returning of the license and the plurality of license rights to the server comprises the first computer initiating return of the license and the plurality of license rights before an expiration of the license and the plurality of license rights.

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Claim 1, emphasis added. Because neither Misra, Irwin, nor Bergler, alone or in combination, teach or suggest such a feature, Applicants respectfully submit that Claim 1, and Claims 2-10 that depend from Claim 1, are patentable under 35 U.S.C. §103(a) over Misra in view of Irwin, and further in view of Bergler.

Claim 11 has been rejected for the same reasons as Claim 1 above. Claim 11 discloses substantially similar limitations as Claim 1, including:

voluntary returning of the license and the plurality of license rights to the server comprises the first computer initiating return of the license and the plurality of license rights before an expiration of the license and the plurality of license rights.

Claim 11, emphasis added. As discussed above with regard to the rejection of Claim 1, neither Misra, Irwin nor Bergler provide such a teaching. Because neither Misra, Irwin, nor Bergler, alone or in combination, teach or suggest such a feature, Applicants respectfully submit that Claim 11, and Claims 12-20 that depend from Claim 11, are patentable under 35 U.S.C. §103(a) over Misra in view of Irwin, and further in view of Bergler.

Claim 11 is alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Misra, Irwin and Bergler as described above and further in view of Fig. 2, 40 of Misra. The Examiner stated:

Claim 11 is rendered obvious as noted above because a computer as depicted in Fig. 2 of Misra, consists of storage capabilities to store copy of software application, store license information, store software application information, store computer identification information, and can operatively link all the information stored on the computer as linked by the System Bus.

12/07/2010 Office Action, p. 13. Applicants respectfully disagree for at least the following reasons.

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Claim 11 is amended to recite:

voluntary returning of the license and the plurality of license rights to the server comprises the first computer initiating return of the license and the plurality of license rights before an expiration of the license and the plurality of license rights.

Claim 11, emphasis added. As discussed above with regard to the rejection of Claim 1, neither Misra, Irwin nor Bergler provide such a teaching. Fig. 2, 40 of Misra does not teach or suggest such a feature either. Figure 2 of Misra shows a block diagram of a computer used to implement a software licensing system described by Misra. Misra, col. 3, lines 33-35. As discussed above, the software licensing system described by Misra does not teach all of the features of Claim 11.

Figure 2 of Misra does not teach:

voluntary returning of the license and the plurality of license rights to the server comprises the first computer initiating return of the license and the plurality of license rights before an expiration of the license and the plurality of license rights.

Claim 11, emphasis added. Because neither Misra, Irwin, Bergler, nor Fig. 2 of Misra, alone or in combination, teach or suggest such a feature, Applicants respectfully submit that Claim 11, and Claims 12-20 that depend from Claim 11, are patentable under 35 U.S.C. §103(a) over Misra, Irwin and Bergler and further in view of Fig. 2, 40 of Misra.

Claim 21 is rejected for the same reasons as Claim 1 above. Claim 21 discloses substantially similar limitations as Claim 1, including:

voluntary returning of the license and the plurality of license rights to the server comprises the first computer initiating return of the license and the plurality of license rights before an expiration of the license and the plurality of license rights.

Claim 1, emphasis added. As discussed above with regard to the rejection of Claim 1, neither Misra, Irwin, nor Bergler provide such a teaching. Because neither Misra, Irwin, nor Bergler,

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alone or in combination, teach or suggest such a feature, Applicants respectfully submit that Claim 21, and Claim 22 that depends from Claim 21, are patentable under 35 U.S.C. §103(a) over Misra in view of Irwin, and further in view of Bergler.

Claim 23 is rejected for the same reasons as Claim 1 above. Claim 23 discloses substantially similar limitations as Claim 1, including:

voluntary returning of the license and the plurality of license rights to the server comprises the first computer initiating return of the license and the plurality of license rights before an expiration of the license and the plurality of license rights.

Claim 1, emphasis added. As discussed above with regard to the rejection of Claim 1, neither Misra, Irwin, nor Bergler provide such a teaching. Because neither Misra, Irwin, nor Bergler, alone or in combination, teach or suggest such a feature, Applicants respectfully submit that Claim 23, and Claims 24-25 that depend from Claim 23, are patentable under 35 U.S.C. §103(a) over Misra in view of Irwin, and further in view of Bergler.

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CONCLUSION

In view of the foregoing, it is believed that all claims now pending (1) are in proper form, (2) are neither obvious nor anticipated by the relied upon art of record, and (3) are in condition for allowance. A Notice of Allowance is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (650) 614-7400. If there are any additional charges, please charge Deposit Account No. 15-0665.

Respectfully submitted,

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